

### **III. REMARKS**

#### **Status of the Claims**

Claims 1, 16, 17 and 18 are amended, and claims 2, 12, and 14 are canceled. Claims 1, 3-11, 13, and 15-19 remain under consideration.

#### **Summary of the Office Action**

Claims 1-6, 15, 18, 19 stand rejected under 35USC102(e) on the basis of the cited reference Prior (EP000913977A2). Claim 7 stands rejected under 35USC103(a) on the basis of the reference Prior in view of the reference Davidson, et al, U.S. Patent No. 5,841,855. Claims 8-11 stand rejected under 35USC103(a) on the basis of the reference Prior in view of the reference Bannister (2012199). Claims 12, 13, and 17 stand rejected under 35USC103(a) on the basis of the reference Prior in view of the reference Gordon, U.S. Patent No. 5,884,156. Claim 14 stands rejected under 35USC103(a) on the basis of the reference Prior in view of the reference Johansson (EP000865184). Claim 18 stands rejected under 35USC112. The Examiner is respectfully requested to reconsider his rejection in view of the following remarks.

Applicant submits that the amendment to claim 18 fully resolves the rejection under 35USC112.

#### **Discussion of the Cited References**

The Examiner relies primarily on the reference Prior, et al to support the rejection of the claims in this application. The reference Prior describes a mobile telephone having a single user interface which may have certain features on the rear face of the

telephone. This is described in column 3, lines 30-35 as follows:

"Moving user interface features from the front face of the handset to another face or faces enables the phone to be reduced in size, particularly in length. Moreover, it often results in a ergonomically improved handset. For example, keys placed on the rear of the handset assist single handed operation, enable more accurate operation as they are actuated using a finger instead of a thumb and are more accessible when the user is in a call"

The functional elements placed on other faces including the rear face are just extended parts of a single user interface and do not operate independently. There are two user interfaces for operation of the mobile phone of this invention one in the front and side faces for normal operation and one in the rear and side faces for operation when the first functional elements are inaccessible. A user interface, as described in amended claim 1 of this application is not taught by the reference Prior et al.

#### **The Issue of Anticipation**

It is well settled that a claim is anticipated, "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See CHISOLM, Federal Circuit Guide, Pg. 1221).

"...it must be shown that the reference contains all of the elements of the claims apart from irrelevant or merely extraneous variations, and the elements are arranged in the same way to achieve the same result which is asserted to be an inventive function..." 454 U.S. 1129 (1981)

The elements of the claim and their function and purpose within the claim must be reviewed in a manner similar to an infringement analysis. If the device described in the cited reference would

not infringe if it was later, it will not anticipate if the reference is earlier.

Applying this standard to the device of the reference Prior it becomes clear that the device of the cited reference is missing significant elements of independent claim 1. There is no provision in the phone of Prior for an independent alternative user interface. Claim 1 states:

**"said third functional elements and second functional elements being arranged so as to together function as a second alternative user interface of a phone independent of said first functional elements, and further wherein said third functional elements comprise at least a rear speaker and a rear microphone."**

Since these elements form no part of the system of Prior, there would be no infringement if Prior was later, therefore, the cited reference Prior does not support the rejection by the Examiner based on anticipation.

The above arguments are equally applicable to the rejected dependent claims 2-6,15 and 18,19.

The reference Prior, et al fails to disclose key features of the subject invention as defined in amended claim 1. None of the additional references cited by the Examiner remedy these deficiencies. The examiner's rejection based on obviousness is therefore, not supported by the cited references either alone or in combination.

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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